



IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
RESPONSE UNDER RULE 116
EXPEDITED HANDLING PROCEDURES

In re Patent Application of
WEBB et al.
Serial No. 09/430,904
Filed: November 1, 1999
Title: POWDER COATED INSULATED BOLTS

Atty Dkt. 839-636
C#/M#
Group Art Unit: 2834
Examiner: Perez
Date: January 7, 2003

Corres. and Mail
BOX AF

Assistant Commissioner for Patents
Washington, DC 20231

Sir:

RESPONSE/AMENDMENT/LETTER

This is a response/amendment/letter in the above-identified application and includes an attachment which is hereby incorporated by reference and the signature below serves as the signature to the attachment in the absence of any other signature thereon.

Correspondence Address Indication Form Attached.

Fees are attached as calculated below:

Total effective claims after amendment	6	minus highest number		
Previously paid for	20	(at least 20) =	0 x \$ 18.00	\$ 0.00
Independent claims after amendment	2	minus highest number		
Previously paid for	3	(at least 3) =	0 x \$ 84.00	\$ 0.00
If proper multiple dependent claims now added for first time, add \$280.00 (ignore improper)				\$ 0.00
Petition is hereby made to extend the current due date so as to cover the filing date of this Paper and attachment(s) (\$110.00/1 month; \$410.00/2 months; \$930.00/3 months)				\$ 0.00
Terminal disclaimer enclosed, add \$ 110.00				\$ 0.00
<input type="checkbox"/> First/second submission after Final Rejection pursuant to 37 CFR 1.129(a) (\$750.00)				\$ 0.00
<input type="checkbox"/> Please enter the previously unentered , filed				
<input type="checkbox"/> Submission attached			SUBTOTAL	\$ 0.00
If "small entity," then enter half (1/2) of subtotal and subtract				-\$ 0.00
<input type="checkbox"/> Applicant claims "small entity" status. <input type="checkbox"/> Statement filed herewith				
Rule 56 Information Disclosure Statement Filing Fee (\$180.00)				\$ 0.00
Assignment Recording Fee (\$40.00)				\$ 0.00
Other:				0.00
			TOTAL FEE ENCLOSED	\$ 0.00

The Commissioner is hereby authorized to charge any deficiency, or credit any overpayment, in the fee(s) filed, or asserted to be filed, or which should have been filed herewith (or with any paper hereafter filed in this application by this firm) to our Account No. 14-1140. A duplicate copy of this sheet is attached.

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NIXON & VANDERHYE P.C.
By Atty.: Michael J. Keenan, Reg. No. 32,106

Signature: Michael J. Keenan

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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE



#23/Reg. for
Reconsid.
Hawkins
1-28-03

In re Patent Application of

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For: POWDER COATED INSULATED BOLTS

* * * * *

January 7, 2003

Assistant Commissioner for Patents
Washington, DC 20231

Sir:

REQUEST FOR RECONSIDERATION

In response to the Final Rejection dated October 23, 2002, applicant requests reconsideration of the rejection of claims 4, 5 and 7 for the reasons stated below.

The Examiner continues to reject claims 4, 5 and 7 under 35 U.S.C. 103 as being unpatentable over Ostwald in view of Duffy and Weidner. The rationale for the rejection is stated in detail on pages 2-4 of the Official Action. In response to the arguments submitted by applicants in the amendment of August 5, 2002, the Examiner makes the following points:

- 1) With regard to Ostwald, the Examiner contends that forming in one piece an article which has formally been formed in two pieces and put together involves only routine skill in the art.

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2) With respect to Duffy, the Examiner notes the integral flange shown in Figure 21.

3) With respect to Weidner, the Examiner contends that Figures 2 and 3 of Weidner disclose a continuous coating 22 between the underside of the flange 21 and the threaded shank, citing column 2, lines 35-43.

The disclosure in column 2 of Weidner indicates that the sleeve 21D can pass completely through the ring 22 (as shown in Figure 4) or simply pass further into the ring 22 than shown in Figure 2, but not completely through the ring into the position shown in Figure 4.

Ultimately, the Examiner concludes that it would have been obvious at the time the invention was made to modify the dynamo-electric machine of Ostwald and provide it with the electrically insulating epoxy powder composition coating disclosed by Duffy in the configuration taught by Weidner for the purpose of improving definition of the resin-type material which is applied over a desired arcuate and vertical area of the threads of the bolt.

The Examiner's rationale is faulty in several respects. For example, it is respectfully submitted that Weidner teaches nothing with respect to any modification of the bolts of Ostwald, even if coated with the powder coating compositions described in Duffy. In other words, Weidner relates to a rubber seal or gasket that, during tightening of the bolt, extrudes downwardly into the hole in the element 30 to be secured, sealing the interface between the bolt threads and the element 30. Thus, the crux of Weidner's disclosure is the manner in which the rubber sealing material extrudes downwardly along

the bolt shank. This is a wholly different concept from the powdered coating compositions described in Duffy, particularly insofar as those compositions cannot reorient themselves in the manner of Weidner's rubber seal.

In addition, it appears that the rubber seal in Weidner could not be successfully employed in Ostwald since the majority of the bolt shank extending from the bolt head in Ostwald is free of threads. Thus, the extrusion action of the rubber seal in Weidner clearly could not occur in the context of Ostwald.

As previously noted, the primary reference to Ostwald discloses a traditional insulating bolt arrangement where the bolt 14 is utilized in combination with a metal washer and an insulating washer 22, with the bolt extending through the core 9 and threaded into the housing 10. A second insulating washer 23 is utilized at the bottom of the core. Thus, Ostwald utilizes no fewer than four separate parts, including the bolt, and, significantly, the bolt shank portion between the first insulating washer 22 and the second insulating washer 23 remains smooth, i.e., has no threads. Applicants' invention relates to an insulating bolt with an integral flange and an epoxy coating applied over defined areas of the flange and shank. As compared to Ostwald, the present invention is more than a mere consolidation of parts. It is a wholly different structure.

Duffy's principal objective is the reduction of insulating drive torque. Thus, Duffy discloses coating the tip end or some additional length of the threaded portion of a fastener with a Teflon™ coating. Duffy seeks to provide a coating that will protect, insulate or mask the threads of the fastener from unwanted contamination or a deposition of material on the threads. By lubricating the threads, the fastener is less likely to pick up

other material such as corrosion inhibitors, fibrous insulation and the like, as the fastener is threaded into a second component. Thus, Weidner would not have suggested extending the coating of Duffy over the underside of a flange at the bolt head since this would have no bearing on torque reduction.

One of ordinary skill in the art, having Ostwald before him, would not have availed himself of the teachings of Duffy in the first instance for the simple reason that there is no concern whatsoever in Ostwald for providing a coating that reduces driving torque. In addition, one of ordinary skill in the art would not have availed himself of the teachings of Weidner since Weidner discloses a rubber seal assembly that clearly would not work in the context of the bolts described in Ostwald, and as already noted, Weidner is in no way relevant to the teaching in Duffy.

Finally, as acknowledged by the Examiner, none of the references teach a powdered epoxy composition that remains functional at an electrical potential of 2500 VDC. The coating in Duffy is effective only up to about 500-600 volts. The assertion that the limitation in the claims amounts to the obvious optimization of a variable, absent supporting evidence, is improper.

Accordingly, in order to meet the requirements of the claims of this application, the Examiner must necessarily resort to impermissible hindsight to pick and choose among specific details of the references with the guidance provided by applicants' disclosure, and to then assert obviousness with respect not only to a combination of those teachings, but also with respect to limitations nowhere suggested in any of the references. Such a combination of prior art references under 35 U.S.C. 103 is clearly improper and

the Examiner is therefore requested to reconsider this single outstanding ground of rejection.

It is respectfully submitted that claims 4, 5 and 7 are in condition for immediate allowance, and early passage to issue is requested.

In the event, however, any small matters remain outstanding, the Examiner is requested to telephone the undersigned so that the prosecution of this application can be expeditiously concluded.

Respectfully submitted,

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